



12-13-02

DTOS Rec'd PCT/PTO 11 DEC 2002

DAC \$

Patent

015110.0085.UTL

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:)
Applicant: Michael R. Briggs, *et al.*) Group Art Unit: Unknown
Serial No.: 09/463,542) Examiner: Unknown
Filed: January 21, 2000)
For: HUMAN PEROXISOME)
PROLIFERATOR ACTIVATED)
RECEPTOR GAMMA (PPAR γ))
GENE REGULATORY)
SEQUENCES AND USES)
THEREFOR)

TRANSMITTAL

Box DAC
Commissioner for Patents
Washington, D.C. 20231

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DEC 16 2002

Dear Sir:

OFFICE OF PETITIONS

Enclosed are the following documents:

- Petition to Revive Under 37 C.F.R. § 1.137(b);
- Declarations of Johan Auwerx, Michael L. Briggs, Regis Saladin; and Lluis Fajas;

CERTIFICATE OF MAILING
(37 C.F.R. § 1.10)

I hereby certify that this paper (along with anything referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as 'Express Mail Post Office To Addressee' in an envelope addressed to the Commissioner for Patents, Washington, D.C. 20231.

EL675947562US
Express Mail Label No.

December 11, 2002
Date of Deposit

SDILIB1\RP02\469990.01

JANICE CRISP
Name of Person Mailing Paper

Janice Crisp
Signature of Person Mailing Paper

- Copy of Petition to Withdraw Holding of Abandonment Under 37 C.F.R. 1.181;
- Copy of Decision on Petition;
- Fee Transmittal for FY 2002 (PTO/SB/17);
- Check in the amount of \$1,280.00; and
- Return postcard.

No additional fee is believed due in connection with this petition, but if any fee is due, the Commissioner is hereby authorized to charge any fee required to our Deposit Account No. **50-1273**.

Respectfully submitted,

BROBECK, PHLEGER & HARRISON LLP

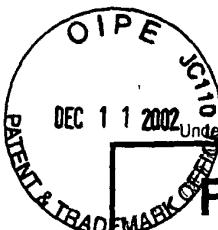
Dated: December 11, 2002

By: Richard H. Pagliery
Richard H. Pagliery
Reg. No. 44,276

RHP/jc

BROBECK, PHLEGER & HARRISON LLP
12390 El Camino Real
San Diego, CA 92130-2081
Telephone: (858) 720-2500
Facsimile: (858) 720-2555

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FEE TRANSMITTAL for FY 2002

Patent fees are subject to annual revision.

TOTAL AMOUNT OF PAYMENT (\$1,280.00)

Complete if Known

Application Number	09/463,542
Filing Date	January 21, 2000
First Named Inventor	Michael R. Briggs
Examiner Name	Unknown
Group Art Unit	Unknown
Attorney Docket No.	015110.0085.UTL

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METHOD OF PAYMENT

1. The Commissioner is hereby authorized to charge indicated fees and credit any overpayments to:

Deposit Account Number 50-1273

Deposit Account Name Brobeck, Phleger & Harrison LLP

Charge Any Additional Fee Required Under 37 CFR 1.16 and 1.17

Applicant claims small entity status. See 37 CFR 1.27

2. Payment Enclosed:

Check Credit card Money Order Other

FEE CALCULATION

1. BASIC FILING FEE

Large Entity Fee Code	Fee (\$)	Small Entity Fee Code	Fee (\$)	Fee Description	Fee Paid
101	740	201	370	Utility filing fee	
106	330	206	165	Design filing fee	
107	510	207	255	Plant filing fee	
108	740	208	370	Reissue filing fee	
114	160	214	80	Provisional filing fee	
				SUBTOTAL (1) (\$)	

2. EXTRA CLAIM FEES

Total Claims	Extra Claims	Fee from below	Fee Paid		
	-20** =	X	=		
Independent Claims	-3** =	X	=		
Multiple Dependent		0	0		
Large Entity Fee Code	Fee (\$)	Small Entity Fee Code	Fee (\$)	Fee Description	Fee Paid
103	18	203	9	Claims in excess of 20	
102	84	202	42	Independent claims in excess of 3	
104	280	204	140	Multiple dependent claim, if not paid	
109	84	209	42	** Reissue independent claims over original patent	
110	18	210	9	** Reissue claims in excess of 20 and over original patent	
				SUBTOTAL (2) (\$)	

**or number previously paid, if greater; For Reissues, see above

FEE CALCULATION (continued)

3. ADDITIONAL FEES

Fee Code	Large Entity Fee (\$)	Small Entity Fee Code	Fee (\$)	Fee Description	Fee Paid
105	130	205	65	Surcharge - late filing fee or oath	
127	50	227	25	Surcharge - late provisional filing fee or cover sheet	
139	130	139	130	Non-English specification	
147	2,520	147	2,520	For filing a request for ex parte reexamination	
112	920*	112	920*	Requesting publication of SIR prior to Examiner action	
113	1,840*	113	1,840*	Requesting publication of SIR after Examiner action	
115	110	215	55	Extension for reply within first month	
116	400	216	200	Extension for reply within second month	
117	920	217	460	Extension for reply within third month	
118	1,440	218	720	Extension for reply within fourth month	
128	1,960	228	980	Extension for reply within fifth month	
119	320	219	160	Notice of Appeal	
120	320	220	160	Filing a brief in support of an appeal	
121	280	221	140	Request for oral hearing	
138	1,510	138	1,510	Petition to institute a public use proceeding	
140	110	240	55	Petition to revive - unavoidable	
141	1,280	241	640	Petition to revive - unintentional	1,280.00
142	1,280	242	640	Utility issue fee (or reissue)	
143	460	243	230	Design issue fee	
144	620	244	310	Plant issue fee	
122	130	122	130	Petitions to the Commissioner	
123	50	123	50	Processing fee under 37 CFR 1.17(q)	
126	180	126	180	Submission of Information Disclosure Stmt	
581	40	581	40	Recording each patent assignment per property (times number of properties)	
146	740	246	370	Filing a submission after final rejection (37 CFR § 1.129(a))	
149	740	249	370	For each additional invention to be examined (37 CFR § 1.129(b))	
179	740	279	370	Request for Continued Examination (RCE)	
169	900	169	900	Request for expedited examination of a design application	

Other fee (specify)

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$1,280.00)

SUBMITTED BY		Complete (if applicable)		
Name (Print/Type)	Richard H. Pagliery	Registration No. (Attorney/Agent)	44,276	Telephone (858) 720-2500
Signature	<i>Richard H. Pagliery</i>			Date December 11, 2002

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.



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Brobeck, Phleger & Harrison LLP

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Brobeck

In re Application of
BRIGGS et al.
Application No.: 09/463,542
PCT No.: PCT/US98/15411
Int. Filing Date: 24 July 1998
Priority Date: 25 July 1997
Attorney Docket No.: 015110.0085.UTL
For: HUMAN PEROXISOME
PROLIFERATOR ACTIVATED
RECEPTOR GAMMA.....

DECISION ON PETITION

This is a decision on applicants' "Request for Withdrawal of Notification of Abandonment under 37 CFR 1.181" which is being treated as a Petition under 37 CFR 1.181 filed in the Patent and Trademark Office (PTO) on 21 December 2001.

BACKGROUND

On 24 July 1998, applicants filed international application no. PCT/US98/15411 which claimed a priority date of 25 July 1997. A proper Demand was filed with the International Preliminary Examination Authority prior to the 19th month from the earliest claimed priority date. As a result, the deadline for payment of the basic national fee was to expire 30 months from the priority date, or at midnight on 25 January 2000.

On 21 January 2000, applicants filed a Transmittal Letter for entry into the national stage accompanied, *inter alia*, by: the requisite basic national fee; a copy of the international application and a preliminary amendment.

On 15 March 2000, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements under 35 U.S.C. 371 indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) along with a surcharge for providing the oath or declaration later than 30 months from the priority date was required. The notification set a one (1) month period for response. The notification was mailed to the attorney of record listed on the 21 January 2000 Transmittal Letter.

On 25 October 2000, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Abandonment (Form PCT/DO/EO/909) indicating that the application was abandoned for failure to file a complete response to the Notification of Missing Requirements mailed 15 March 2000 within the time period set therein. The

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Notification of Abandonment was mailed to the attorney of record listed on the 21 January 2000 Transmittal Letter.

On 13 October 2000, applicants filed a Status Inquiry Letter. In a communication dated 29 November 2000, the PCT Legal Office responded to applicant's status request indicating that the above-identified application was abandoned. The notification was mailed to Brobeck, Phleger & Harrison, 12390 El Camino Real, San Diego, California 92130.

On 06 September 2002, applicants filed "Change of Correspondence Address" and "Request for Withdrawal of Notification of Abandonment."

DISCUSSION

Petitioner asserts that the delay in responding was caused by nonreceipt of the Notification of Missing Requirements dated 15 March 2000. A review of the written record indicates that the Notification dated 15 March 2000 was addressed to the correspondence address on file as of 15 March 2000 and indicates no irregularity in the mailing of the Notification. In the absence of any irregularities there is a strong presumption that the Notification was properly mailed to the address of record and this presumption may be overcome by a showing that the Notification was not in fact received. The showing required to establish the failure to receive an Office action must consist of a statement from the practitioner stating that the Office action was not received by practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office action was not received. A copy of the docket record where the non-received Office action would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement.

Applicants state in their present petition that, "[a]pplicants' representatives moved their offices Lyon & Lyon . . . to Brobeck, Phleger, & Harrison . . . throughout February and March of 2000. Correspondence was forwarded from Lyon & Lyon to Brobeck, Phleger, & Harrison as a routine matter. But applicants' representative did not receive the Notification of Missing Requirements that was mailed by the Patent Office on March 15, 2000."

Applicants' counsel has attested that the Office action was not received by the practitioner and that a search of the file jacket and docket records indicates that the Notification of Missing Requirements was not received. Applicants' representative has provided a copy of a docket record, however, it is unclear if the docket record is for Lyon & Lyon or Brobeck, Phleger, & Harrison. Additionally, a review of the application papers reveals that a change of correspondence address was not filed for the present application until 06 September 2000. Section 601.3 Change of Correspondence Address, Manual of Patent Examining Procedure states, "[w]here an attorney or agent of record changes his or her correspondence address . . . a separate notification must be filed in each application for which a person is intended to receive communications from the Office." Applicants have failed to show that a proper change of correspondence address was filed prior to 15 March 2000 or show that the Notification mailed 15 March 2000 was not received at the address of record detailed above.

Thus, applicants have not provided the proper showing necessary to withdraw the holding of abandonment and the petition may not be properly granted.

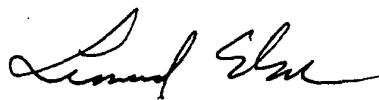
CONCLUSION

The Petition to Withdraw Holding of Abandonment under 37 CFR 1.181 is **DISMISSED** without prejudice and the application remains **ABANDONED**.

Applicants may wish to consider filing a petition to the Commissioner under 37 CFR 1.137(a) or (b) requesting that the application be revived. Any petition filed under 37 CFR 1.137(a) and/or a petition under 37 CFR 1.137(b) requesting that the application be revived must meet the criteria indicated in the recent revision of 37 CFR 1.137. This recommendation to file a petition under 37 CFR 1.137(a) or (b) should not be construed as an indication as to whether or not any such petition(s) will be favorably considered.

If reconsideration of the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.181." No additional fee is required. Extensions of time under 37 CFR 1.136(a) are permitted.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, DC 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



Leonard Smith
Legal Examiner
Office of PCT Legal Administration



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